

REMARKS

Claim 1 has been amended, and new independent claim 20 has been added.

Claim 1 was narrowed substantially, for example by incorporating certain limitations recited in paragraphs [0044] and [0045] of the specification.

New independent claim 20 consists of the subject matter of original claim 1 with the additional limitation that compounds in “(D)” are selected from among those preferred examples recited in paragraph [0055] of the specification.

The present amendment adds no new matter to the application.

The Rejections

Claims 1, 2, 4-6, 11, 13, 15, 16, 18, and 19 stand rejected under 35 U.S.C. § 102(b) in view of Gries et al. (U.S. 2003/0186165) [hereinafter “Gries”] (equivalent to JP2003-295426).

Claim 1-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gries in view Ohta et al. (U.S. 5,476,690) [hereinafter “Ohta”].

In view of the present amendment, Applicants respectfully traverse the present rejections and request reconsideration and allowance of the claims for the following reasons.

Applicant’s Arguments

Rejection under 35 U.S.C. § 102

Regarding the rejection of claim 1, Gries teaches a printing plate precursor comprising an optical brightening agent as a sensitizer (paragraph 0001). Gries discloses a multitude of compounds, including 2,5-bis(4’-diethylaminophenyl)-1,3,4-oxadiazole (paragraph 0036). However, Gries fails to teach, or even suggest, any compounds falling within the scope of claim 1 as presently amended. In particular, claim 1 now excludes the 2,5-diphenyl-1,3,4,-

oxidazole compounds in component (D). Thus, claim 1 is novel and patentable over Gries, as are its dependent claims 2-19.

Gries especially fails to teach, or even suggest, any compounds recited in the component (D) of new independent claim 20, which specifically enumerates a small list of compounds for this component of the claimed photosensitive resin composition. Thus claim 20 is also novel and patentable over Gries.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

Rejection under 35 U.S.C. § 103

The claims as currently amended are also nonobvious over the prior art. To establish obviousness, it must be shown that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so. Pharmastem Therapeutics, Inc. v. Viacell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007) (citing KSR Int'l Co. v. Teleflex Inc., --- U.S. ----, 127 S.Ct. 1727, 1740, 167 L.Ed.2d 705 (2007)).

Gries teaches a printing plate precursor comprising an optical brightening agent as a sensitizer (paragraph 0001), and recites an extremely large list of compounds. For examples of optical brightening agents, Gries names silbene-types compounds, distyrylbenzene type compounds, benzooxazole type compounds, FLAN type compounds, diphenylpyrazoline type compounds and coumarin type compounds. As noted above, Gries fails to teach, or even suggest, compounds of general formulae (1a), (1b), (1c), or (2) recited in the present claim 1, nor the list of compounds “(D)” recited in claim 20. The Examiner admits that Ohta fails to disclose such compounds (Office Action dated July 25, 2007, page 4). Thus, no *prima facie* case of obviousness exists as against the present claims, and Applicants respectfully traverse

and request reconsideration of the rejection under 35 U.S.C. § 103.

Even if Gries taught a compound “(D)” of the presently-claimed invention, which Gries does not, one of ordinary skill in the art would have had no reason to select that compound (from among the long listing of compounds in Gries) to use in a combination. Furthermore, the claimed invention aims for and achieves high resolution, adhesion, and low plating bath contamination, and one of skill in the art would not look to Gries to achieve these ends.

Superior and Unexpected Results

Applicants attach herewith test results in the form of a Declaration Under Rule 132 showing that photosensitive resin compositions with compounds “(D)” according to the present invention exhibit superior and unexpected results over those employing 2,5-diphenyl-1,3,4,-oxadiazole. One of ordinary skill in the art could not predict that the claimed invention would perform in this surprisingly superior fashion as compared to compositions using the sort of compound recited Gries. Thus, Applicants further traverse the rejection under § 103.

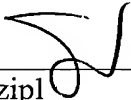
Conclusion

For all of the above reasons, claims 1-20 are now in condition for allowance. Therefore, Applicants respectfully request reconsideration of the application and withdrawal of the rejections, and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below signed attorney for the Applicants.

Respectfully submitted,

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